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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,266	04/19/2001	Satoe Okayasu	500.40031X00	8043

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

EL HADY, NABIL M

ART UNIT PAPER NUMBER

2154

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/837,266	Applicant(s) OKAYASU ET AL.	
	Examiner Nabil M. El-Hady	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2154

1. Claims 1-10 are pending in the application. Claims 1, 2, 4-7, and 9 are cancelled. Claims 3 and 8 are amended. Claim 10 is new.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 3, 8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following phrases are not clearly understood and are rendering claim 3 vague or indefinite:

a) "one or more boards", line 3, it is unclear what are these board used for. A general interpretation of a board does not fit with the purpose of retrieving information. It is proposed to define a board in the claim as a cite for communication and retrieving information between participating speakers;

b) "one or more cards", line 3, it is unclear what are these cards used for. A general interpretation of a card does not fit with the purpose of retrieving information. It is proposed to define a card in the claim as a holder for speech content of one of the participating speakers;

c) "a speaker mark", line 5, a speaker is not yet defined in order to define a speaker mark;

d) "is put on speaker mark putting areas", line 5, it is unclear if "put" here is interpreted as "available" or "stored", and it is unclear if "putting areas" here is interpreted as "storage areas" in the board;

e) "for retrieval each provided on a board", lines 5-6, the meaning is not clear;

f) "taking out information", it is unclear what taking out means, and taking it out where;

g) "keyword for retrieval", line 8, it is unclear what retrieval here is referring to. It is proposed to make it clear as retrieval of speech content on said one or more cards.

h) "or the like", line 8, may not be used in the claim, as its usage does not clearly spell out what is or what is not included in the claim;

i) "displaying said taken-out information", line 9, it is unclear where and to whom this information is displayed;

j) "a client terminal", line 14, it is unclear if "a client" and "a user" mean the same thing, say "participant", and "a client terminal" is "a user terminal";

k) "board information cached in a client terminal", lines 13-14, it is unclear what type of information is this "board information", and when it is cached in the client terminal;

l) "displaying ... a card", line 15, it is unclear if the card itself is displayed or the information (i.e. speech content) is displayed;

B. The following has no antecedent basis in claim 3:

a) "user", line 7; and "the user", line 10;

b) "board information", line 13;

Art Unit: 2154

C. The following phrases are not clearly understood and are rendering claim 8 vague or indefinite:

a) "A communication comprising", line 1, it is unclear if this represent communication method, system, product, or etc.

b) "one or more boards", line 5, it is unclear what are these board used for. A general interpretation of a board does not fit with the purpose of retrieving information. It is proposed to define a board in the claim as a cite for communication and retrieving information between participating speakers;

c) "one or more cards", line 5, it is unclear what are these cards used for. A general interpretation of a card does not fit with the purpose of retrieving information. It is proposed to define a card in the claim as a holder for speech content of one of the participating speakers;

d) "a speaker mark", line 6, a speaker is not yet defined in order to define a speaker mark;

e) "is put on speaker mark putting areas", line 7, it is unclear if "put" here is interpreted as "available" or "stored", and it is unclear if "putting areas" here is interpreted as "storage areas" in the board;

f) "for retrieval each provided on a board", lines 8, the meaning is not clear;

g) "taking out information", it is unclear what taking out means, and taking it out where;

h) "keyword for retrieval", line 10, it is unclear what retrieval here is referring to. It is proposed to make it clear as retrieval of speech content on said one or more cards.

i) "or the like", line 10, may not be used in the claim, as its usage does not clearly spell out what is or what is not included in the claim;

j) "retrieval request", line 15, and "retrieval result", line 17, it is unclear retrieval for what. It is proposed to make it clear that retrieval request for speech content on said one or more cards;

k) "using information embedded in multimedia data", lines 18-19, it is unclear what or where is this information that is embedded, and what is this multimedia data coming from;

l) "board introduction", it is unclear what is a board introduction;

m) "member condition", it is unclear what member is referring to, or what condition is referring to.

D. The following phrases are not clearly understood and are rendering claim 10 vague or indefinite:

a) "a method for editing", line 1, it is unclear what is being edited;

b) "a speaker mark", line 2, a speaker is not yet defined in order to define a speaker mark;

c) "in advance", line 2, it is unclear in advance to what;

d) "one or more cards", line 3, it is unclear what are these cards used for. A general interpretation of a card does not fit with the purpose of editing information. It is proposed to define a card in the claim as a holder for speech content of one of the participating speakers;

e) "a first board", line 3, it is unclear what a board is used for. A general interpretation of a board does not fit with the purpose of editing information. It is proposed to define a board in the claim as a cite for communication and retrieving information between participating speakers;

f) "one or more cards each having a speaker mark put thereon", lines 3-4, it is unclear if the speaker mark is put (stored) on the card or on the board (as is indicated in claims 3 and 8 above).

g) "re-edition in advance", line 5, it is unclear what is being edited or re-edited, and how it can be performed in advance;

h) "inputting an extraction keyword", line 6, it is unclear where to input the keyword;

i) "an extraction keyword", line 6, it is unclear the difference between "an extraction keyword", "an edition keyword" in line 2, and "the keyword" of line 8;

j) "a second board in correspondence to a attribute of said second board", lines 9-10, it is unclear what are these attributes of the second boards that is used in choosing a second board out of second board to put the extracted card on.

4. Claims 3, 8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 3, 8, and 10 fail to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed 12/28/2004. In that paper, applicant has stated that the features of the present invention as now are clearly recited in claims 3, 8, and 10 are not taught or suggested by examiner's cited prior art, and this statement indicates that the invention is different from what is defined in the claim(s) because the statement also indicates that carrying out communications taking into account of the range of disclosure of a board and card to the public and requirements for allowing a person to join the community is a feature of the invention which is not in the claims. The statement also indicates that being equipped with the speaker assisting function to allow the user to do retrieval with one operation using the speaker mark, and

Art Unit: 2154

template of boards are prepared so that a card can be moved among the boards that use different templates is also a feature of the invention that is not in the claims. The statement also indicates that a speaker function is of icon type with data on attributes of a speaker is a feature of the invention that is not in the claims. The statement also indicates that the speaker mark has been embedded on a retrieval processing activation button so as to allow the retrieval process to start is a feature of the invention which is not in the claims. The statement also indicates that specifying a keyboard for retrieving a board, which a speaker can join, an interesting board, and a card on which the same opinion has been written which is not in the claims.

5. Claims 3, 8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements or method steps, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are clearly referred to in the previous rejections.

6. Claims 3, 8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are clearly referred to in the previous rejections

7. Claims 3, 8, and 10 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the device, must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

8. Claims 3, 8, and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

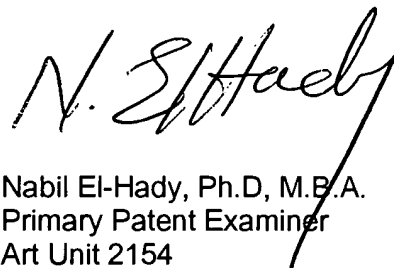
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M. El-Hady whose telephone number is (571) 272-3963. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2154

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 31, 2005


Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
Art Unit 2154